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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/008,531	01/16/98	RHODES	H MI0012V2

MM42/0930
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EXAMINER	
EATON, K	
ART UNIT	PAPER NUMBER

2823

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DATE MAILED: 09/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/008,531

Applicant(s)
Rhodes et al.

Examiner
Kurt Eaton

Group Art Unit
2823



☒ Responsive to communication(s) filed on Jun 1, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 21-30 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 21-30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 34

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Oath/Declaration

1. Receipt is acknowledged of the Supplemental Communication to the Examiner, the Declaration of Coinventor Luan Tran, and of the Supplemental Declaration of Coinventor Howard E. Rhodes in Paper No 5, however, a supplemental oath or declaration meeting the requirements of §1.63 is required under 37 CFR 1.67 to be filed to correct the deficiencies and/or inaccuracies (i.e., the addition of coinventor Luan Tran) in the earlier filed declaration. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to

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make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Subject matter not properly described in the application as filed (i.e., application as filed in parent application 08/789,072 filed 2/3/97) is found in the second line of newly added Claim 29 as found in the Preliminary Amendment of the present application.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 21-28 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, and 8 of U.S. Patent No. 5,827,770.

Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 5,827,770 claims a process for making a semiconductor device having an

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improved contact to a conductive layer, including the steps of: a. forming an underlayer structure of material having an opening therein {column 8, lines 2-6}; b. forming a layer of first conductive material on the underlayer and in the opening (i.e., along the surfaces of sidewalls of the opening) {column 8, lines 7-8}; c. forming an overlayer of material on the layer of first conductive material and etching a contact hole therethrough {column 8, lines 9-11}; d. forming a localized thick region in the layer of first conductive material within the opening subjacent the contact hole thereby forming the localized thick region to be defined by a vertical spacer made of the first conductive material {column 8, lines 12-14}; and e. forming a conductor contacting the thick region and the vertical spacer component through the contact hole thereby substantially filling the contact hole in the overlayer {column 8, lines 15-16}. U.S. Patent No. 5,827,770 also claims wherein the first conductive material is a capacitor electrode {column 8, lines 49-55}. Finally, U.S. Patent No. 5,827,770 claims wherein the conductor includes polysilicon material {column 8, lines 56-57}.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the underlayer and the overlayer of U.S. Patent No. 5,827,770 such that they comprised insulating materials since it is well known that contact holes and openings in underlayers which selectively expose portions of a semiconductor device are formed in insulative materials.

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Conclusion

7. Paper related to this application may be submitted directly to Art Unit 2823 by facsimile transmission. Papers should be faxed to Art Unit 2823 via the Art Unit 2823 Fax Center located in the Crystal Plaza 4, room 4C23. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2823 Fax Center number is **(703) 308-7722 or -7724**. The Art Unit 2823 Fax Center is to be used only for papers related to Art Unit 2823 applications.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Kurt Eaton** at **(703) 305-0383** and between the hours of 8:00 AM to 4:00 PM (Eastern Standard Time) Monday through Friday or by E-mail via **Kurt.Eaton@uspto.gov**.



Wael Fahmy
SUPERVISORY PATENT EXAMINER
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